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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/762,595	01/21/2004	Steven William Doane	51813/8:1 US	5054

7590 10/27/2004

Sandra K. Szczerbicki  
Suite 2600  
900 SW Fifth Avenue  
Portland, OR 97204-1268

EXAMINER

TRAN, THAO T

ART UNIT PAPER NUMBER

1711

DATE MAILED: 10/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/762,595

**Applicant(s)**

DOANE ET AL.

**Examiner**

Thao T. Tran

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 15-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 and 20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |  |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>1/21/04</u> . | 6) <input type="checkbox"/> Other: ____  |

## DETAILED ACTION

### *Election/Restrictions*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-14 and 20, drawn to a method of making a superabsorbent polymer, classified in class 527, subclass 312.
  - II. Claims 15-19, drawn to a method of use, classified in class 47, subclass 1.01.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as process of making and process of using the product.

The use as claimed cannot be practiced with a materially different product. Since the product is not allowable, restriction is proper between said method of making and method of using. The product claim will be examined along with the elected invention (MPEP § 806.05(i)).

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

5. During a telephone conversation with Ms. Sandra Szczerbicki on October 21, 2004 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-14 and 20. Affirmation of this election must be made by applicant in replying to this Office

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action. Claims 15-19 have been withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

#### ***Claim Objections***

7. Claims 11-12 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Claims 11-12 depend on claim 10. However, the particle size in claim 11 and claim 12 are larger than that in claim 10. It is hereby noted that particle size is inversely proportional to mesh size, thus the higher the mesh size, the smaller the particle size.

Appropriate correction is required.

#### ***Double Patenting***

8. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

9. Claims 1-14 and 20 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-14 and 20 of copending Application No. 10/762,956. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented. The instant claims 1-4 and 20 are exactly identical to claims 1-14 and 20 of copending Application No. 10/762,956.

***Claim Rejections - 35 USC § 102***

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 1-14 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Weaver et al. (US Pat. 3,935,099) or Fanta et al. (US Pat. 4,134,863).

Weaver teaches a starch graft copolymer and a method of making, the method comprising graft copolymerizing acrylonitrile on starch in the presence of ceric ammonium nitrate as a polymerization initiator; saponifying the starch graft copolymer; precipitating the starch graft copolymer by acid or adding an alcohol (methanol); and granulizing (milling) the copolymer. The weight ratio of starch to acrylonitrile is 1:1.5 (40:60) or 1:3 (25:75). The particle size is 20-

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mesh (See col. 3, ln. 40-46; col. 4, ln. 1-23, 45-68; col. 5, ln. 10-14; Tables 1,9). Weaver further teaches the product useful in agricultural applications (see col. 2, ln. 23-26).

Fanta teaches a starch graft copolymer and a method of producing, the method comprising graft polymerizing grafting reactants onto starch to form a starch graft copolymer; saponifying the starch graft copolymer; precipitating the starch graft copolymer with an alcohol (ethanol); and granulizing (milling) the copolymer. The starch used is flour, meal, cornstarch, or gelatinized starch. The grafting reactants comprise ceric ammonium nitrate as an initiator and acrylonitrile, wherein the acrylonitrile is acrylic acid, acrylamide, or 2-acryloamido-2-methylpropane sulfonic acid. The weight ratio of starch to acrylonitrile is 1:1.5 (40:60) or 1:3 (25:75). The particle size is 20-mesh. (See col. 2, ln. 17-22, 40-41, 60 to col. 3, ln. 12; Example 1).

With respect to the use of the polymer product, it has been within the skill in the art that intended use would have no significant patentable weight when a product or a method claim is being considered.

### ***Contact Information***

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thao T. Tran whose telephone number is 571-272-1080. The examiner can normally be reached on Monday-Friday, from 8:30 a.m. - 5:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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October 21, 2004

*Thao Tran*  
THAO T. TRAN  
PATENT EXAMINER